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09/552,044	04/19/2000	Hans-Ulrich Buschhaus	Mo-5586-LeA 33,605	3337

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EXAMINER
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REDDICK, MARIE L

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1713

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Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Application Number: 09/552,044  
Filing Date: April 19, 2000  
Appellant(s): BUSCHHAUS ET AL.

**MAILED**

OCT 06 2004

**GROUP 1700**

Diderico van Eyl  
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 19, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying that there are no related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 40-47 stand together as a single group.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

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3,113,399	EVERSOLE et al	12-1963
5,972,971	HEUER et al	10-1999
5,990,143	LUDWIG et al	11-1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 40-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited "acrylate dispersions" constitutes indefinite subject matter as per the metes and bounds of such engender indeterminacy in scope, i.e., it is not readily ascertainable as to whether "acrylate monomer(s)", "acrylate resin(s)" or else is intended.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 40-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eversole et al (U.S. 3,113,399) in combination with Heuer et al (U.S. 5,972,971).

Eversole et al disclose and exemplify aqueous protective coatings for seeds, against fungi, disease and insects, wherein, said coating compositions are defined basically as containing a paint vehicle which includes acrylic resins, alkyd resins, in particular 23 % penta soya oil alkyd resin(BB-6-60), water, nutrients, fungicides, emulsifiers, etc. See, e.g., cols. 1 and 3. More specifically, Eversole et al exemplify aqueous seed coating compositions containing, basically, water, as a paint vehicle, maleic anhydride modified drying oil, Captan(fungicide), emulsifier(Triton X-100) and other conventional adjuncts. See Run II.

The disclosure of Eversole et al differs basically from the claimed invention as per the non-express disclosure of an embodiment directed to the specifically defined (A) components. Eversole et al, however, @ col. 3, lines 11-19 and Run II teach that fungicides such as Captan(sulfenamide) may be added to the compositions to provide protection against fungi.

Heuer et al @ col. 4, lines 58-59 & col. 6, lines 7-11 teach that fungicidal compounds, viz., sulfenamides such as dichlorofluanid, tolylfluand, fluorfolpet and captan are well known equivalents for use against wood-destroying fungi. Therefore, it would have been obvious, on its face, to use sulfenamides such as dichlorofluanid, tolylfluand and/or fluorfolpet as the fungicide(s), taught as equivalents in scope for protection against fungi, in the compositions of Eversole et al and with a reasonable expectation of obtaining equivalent results, i.e., a reasonable expectation of success. More specifically, it would have been obvious to the skilled artisan to swap the Captan per Run II for any of the antecedently recited fungicides disclosed as operable equivalents per Heuer et al and with a reasonable expectation of success with the understanding that one of ordinary skill in the art would have readily envisioned the use of the oil-modified alkyd resin used in Run VII in lieu of the maleic anhydride modified drying oil per Run II since they are

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taught as operable equivalents at col. 3, lines 24-42. It is the base presumption that the aforementioned alkyd resin may very well possess the claimed pH value since it is essentially the same as the claimed binder component and in the absence of the USPTO having at its disposal the tools deemed necessary to make physical determinations of this sort. Even if this turns out not to be the case, the use of any commercially available vegetable oil alkyd resin in lieu of the penta soya oil alkyd resin would have been obvious to the skilled artisan and with a reasonable expectation of success. Criticality for such, commensurate in scope with the claims, not having been demonstrated on this record.

As to the storage stability of the composition of Eversole et al, as modified, it would be expected that the composition of Eversole et al would be storage stable since the composition of Eversole et al, as modified, is essentially the same as the claimed composition.

A prima facie case of obviousness (for a composition) does not require the solution of the same problem or recognition of the same advantages as the applicant's invention. In re Dillon 16 USPQ2nd 1897 (CAFC, en banc, 1990), which overrules In re Dillon 13 USPQ 2nd 1337 and In re Wright 6 USPQ 2nd 1959.

The fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

The introductory phrases "A method for protecting" and "A method for stabilizing" per claims 43 and 45, respectively, which is basically the result of combining water, at least one binder selected from the group consisting of (i) alkyd resins based on vegetable oils and (ii) acrylate dispersions having a  $\text{pH} \leq 7$  and a component selected from the group consisting of dichlofluanid, tolylfluanid, fluorfolpet and mixtures thereof and, as such, do not serve to patentably distinguish the claimed method from the system of Eversole et al, as modified. While Eversole et al may not show a specific recognition of these results, that discovery by

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appellant is tantamount only to finding a new property in an old composition. Such recognition does not impart patentability to an otherwise old composition as provided for under the auspices of *In re Tomlinson et al* (363 F. 2d 928, 150 USPQ 623 (CCPA 1966)).

#### Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 40-47 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ludwig et al (U.S. 5,990,143).

Ludwig et al disclose water-based, solvent and emulsifier-free, microbial active compound-governed compositions for use in fields of application such as water-based wood preservatives. In particular, Ludwig et al disclose aqueous and optionally organic solvent- and emulsifier-free microbicidal active compound

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combinations comprising known azole fungicides and quaternary ammonium fungicides. Further, Ludwig et al @ col. 2, lines 12-16 disclose that one object of the invention is to provide, preferably, water-based, solvent- and emulsifier-free microbicidal active compound formulations based on azole fungicides, which can be diluted easily with water and then give storage-stable solutions for use. Ludwig et al @ col. 3, lines 26-48 teach that to prepare aqueous formulations, the active compounds are incorporated individually or as an active compound combination, for example in the form of powders, granules, pastes or concentrated solutions, suspensions or emulsions, into water by simple mixing, and are then present in the form of an aqueous suspension, solution or emulsion and that the aqueous solutions or emulsions preferably contain more than 20% by weight, in particular more than 40% by weight of water and can be diluted with water as desired to the use concentration. Ludwig et al further teach that the microbicidal agents contain the active compound combination in a concentration of 0.001 to 95% by weight, in particular 0.01 to 60% by weight, and in addition optionally 0.001 to 30% by weight, in particular 0.01 to 20% by weight, especially 0.05-10% by weight, of a suitable additional fungicide, insecticide or an additional active compound which includes sulphenamides such as dichlofluanid (Euparen), tolylfluanid (Yethyleuparen), folpet or fluorfolpet. Furthermore, Ludwig et al @ col. 4, lines 22-59 teach that the compositions may further contain binders such as acrylic resins, vegetable oil-containing alkyd resins (reasonably presumed to have a pH value falling within the scope of the claims since the resins are essentially the same as the claimed resins and in the absence of the USPTO to have at its disposal, the tools and facilities to make physical determinations of this sort). Ludwig et al therefore anticipate the instantly claimed invention with the understanding that "comprising" leaves the claims open for the inclusion of unspecified ingredients, even in major amounts (Ex parte Davis et al, 80 USPQ 448). However, even if this turns out not to be the case, the use of any commercially available vegetable oil-containing alkyd resin in lieu of the vegetable oil-containing alkyd resin



of Ludwig et al would have been prima facie obvious to the skilled artisan and with a reasonable expectation of success.

The introductory phrases "A method for protecting" and "A method for stabilizing" per claims 43 and 45, respectively, which is basically the result of combining water, at least one binder selected from the group consisting of (i) alkyd resins based on vegetable oils and (ii) acrylate dispersions having a  $\text{pH} \leq 7$  and a component selected from the group consisting of dichlofluanid, tolylfluanid, fluorfolpet and mixtures thereof, as such, do not serve to patentably distinguish the claimed methods from the system of Ludwig et al. While Ludwig et al may not show a specific recognition of these results, this discovery by appellant is merely tantamount only to finding a new property in an old composition. Such recognition does not impart patentability to an otherwise old composition as provided for under the auspices of *In re Tomlinson et al* (363 F. 2d 928, 150 USPQ 623 (CCPA 1966)).

(11) Response to Argument

A) Relative to the rejection of Claims 40-47 under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph---Appellant argues that, when read in light of the specification, the term "acrylate dispersions" would be readily understood by one having ordinary skill in the art. To his end, it is urged and maintained that the metes and bounds of the recited "acrylate dispersions" engenders indeterminacy in scope. There are two separate requirements set forth in the § 112, second paragraph:

(A) the claims must set forth the subject matter that applicants regard as their invention; and

(B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

See M.P.E.P. § 2171.

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To this end, the limitations on which appellant relies are not stated in the claims. It is the claims that define the claimed invention and it is the claims and not the specification that are anticipated or unpatentable.

Constant v. Advanced Micro-devices Inc., 7 USPQ 2d. 1064. Claims may be interpreted in light of the specification for purposes of defining a given term under 35 USC 112 but it must be remembered that during patenting examination the pending claims must be interpreted as broadly as their terms reasonably allow. In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Although a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See In re Prater, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969) and In re Winkhaus, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claim that are not recited in the claim.

Moreover, "acrylate dispersion(s)" is as it appears in the specification (page 2, lines 12 & 15).

B) Relative to the Rejection under 35 USC § 103 (a) over Eversole et al in combination with Heuer et al--- It is urged and maintained that the instantly claimed invention is obvious within the meaning of 35 USC 103 over Eversole et al in combination with Heuer et al as per reasons stated in the Grounds of Rejection supra.

The crux of Appellant's arguments appears to hinge on a) the aqueous compositions of Eversole et al, as modified by Heuer et al, not engendering storage stable formulations & b) the impermissible use of hindsight reconstruction.

As to item a), it is urged and maintained that the aqueous composition of Eversole, as modified, would be expected to possess storage stability since the aqueous composition of Eversole, as modified, is essentially the same as the claimed aqueous system. Moreover, Appellant is cordially directed to the paragraph bridging cols. 2 and 3 of Eversole et al wherein storage of the aqueous coating is discussed. There is

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absolutely nothing viable on this record diffusing this issue. Appellant has not proffered any objective evidence establishing that the coating composition of Eversole et al, as modified, is not storage stable. Mere Appellant's arguments unsupported by factual evidence are given little weight, *In re Lindner* (173 USPQ 356).

As to item b), in response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

C) Relative to the rejection under 35 USC§ 102 (e)/103(a) over Ludwig et al---The crux of Appellant's arguments appear to hinge on Ludwig et al not teaching or suggesting to one of ordinary skill in the art how to prepare ready to use storage stable formulations containing a compound selected from the group consisting of dichlofluanid, tolyfluanid and fluorfolpet. With all due respect to the opinion of Appellant, it is urged and maintained that the instantly claimed invention is anticipated by, or in the alternative, obvious over Ludwig et al as per reasons clearly stated in the Grounds of Rejection supra. As to the active compound/vegetable oil-modified alkyd resin -containing aqueous formulation, Appellant is reminded that a reference is evaluated, as a whole, for what it fairly teaches and is in no way limited to the working examples, i.e., the specification need not contain an example if the invention is otherwise disclosed in such manner that one skilled in the art will be able to practice it without an undue amount of experimentation. *In re Borkowski*, 422 F.2d 904, 908, 164 USPQ 642, 645 (CCPA 1970).

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Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use. In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994).

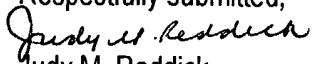
All disclosures in reference patent must be evaluated, including nonpreferred embodiments; reference is not limited to disclosure of specific working examples. In re Mills and Palmer, 176 USPQ 196 (CCPA 1972).


Furthermore, as to storage stable, ready-to-use aqueous formulations, Appellant is cordially directed to col. 2, lines 12-16 and col. 8, line 56 that state, in essence, that one of the objectives of the instant invention is to provide storage-stable, ready-to-use aqueous solutions. As to the "azole fungicides", the claims, in their present form, simply don't preclude such compounds since "comprising" leaves the claims open for the inclusion of unspecified ingredients, even in major amounts (Ex parte Davis, 80 USPQ 448, 450 (Bd. App. 1948)).


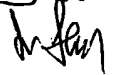
For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,  
  
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Primary Examiner  
Art Unit 1713

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October 1, 2004

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